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PTO/SB/33 (07-06)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>000600-036</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>08/22/2006</u> Signature <u>David J Ser</u> Typed or printed name <u>DAVID J SERBIN</u>		Application Number <b>09/700,747</b> Filed <b>November 20, 2000</b> First Named Inventor <b>Nooli-Baker</b> Art Unit <b>1762</b> Examiner <b>Fletcher, III</b>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,589</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>David J Serbin</u> Typed or printed name <b>DAVID J. SERBIN</b> Telephone number <b>703 299 0035</b> Date <b>08/22/2006</b>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Aug 22 2006 17:52 White, Redway & Brown LLP 703-299-0036

p.5

Aug 22 2006 4:41PM Law Office of David J Ser 703-823-8653

p.5

In re Patent Application of

Nasli-Bakir et al

Application No. 09/700,747

Filed: November 20, 2000

For: METHOD OF APPLICATION

Attorney Docket No. 000600-036

Confirmation No. 4239

Group Art Unit: 1762

Examiner: William P. Fletcher III

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**AUG 22 2006**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
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Alexandria, VA 22313-1450

Sir:

Appellants request a review of the Final Rejection mailed February 22, 2006 in view of the following remarks.

Patent  
Attorney's Docket No. 000600-016

### **REMARKS**

The claimed invention relates to a method of applying an amino resin gluing system to a substrate. As claimed in claim 39, the method includes the steps of feeding an amino resin component to at least a first orifice, feeding a hardener component to at least a second orifice, and discharging the resin and hardener through their respective orifices in the form of strands or spray onto the substrate. The discharged components remain physically isolated from each other until at least one of the components contacts the substrate. The hardener is a volatile acid and is either free from filler or includes filler in an amount of less than 20% by weight. Appellants have found that when the amount of filler in the amino resin adhesive is kept below 20%, as claimed, delamination is greatly reduced. This result was quite unexpected, and is neither taught nor suggested by the prior art. Example 1 of the specification demonstrates and quantifies this unexpected result.

The Examiner has rejected all of the claims based on the combination of Andersson (EP 0207024) in view of Lehnert (WO 89/05221). Some rejections also include one or more of Perciwall (EP 0016740), Menger (US 2,015,806) and Toshio (JP 61-040137) as additional secondary references.

A personal interview was conducted with Examiner Fletcher and his supervisor, Examiner Meeks, on October 11, 2005. At the interview, it was suggested that appellants prepare and file a Declaration under 37 CFR 1.132 based on the teaching of the primary reference of Andersson, in which data points regarding delamination were presented comparable to those in applicants' Example 1. In addition, it was suggested that the Declaration provide some rationale that amino resin adhesives other than that used in Example 1 would function in an equivalent manner. Appellants agreed to consider such a declaration. However, after careful consideration, they have instead decided to appeal, on the basis that the Examiner has failed to establish a *prima facie* case of obviousness, and consequently no Declaration under 37 CFR 1.132 is necessary for a finding of patentability.

Patent  
Attorney's Docket No. 000600-016

No Prima Facie Case of Obviousness

In the Office Action mailed January 14, 2005, page 7, the Andersson reference is cited for teaching:

a method of applying a two-component gluing system to a substrate in which the resin component and the hardener component are separately applied to the substrate in the form of separate, parallel strands [abstract]. The components are applied through a nozzle (i.e., orifice) [p.6, ll. 9-17]. The two components do not contact each other until the substrate surfaces are joined together [p. 6, ll. 15-17]....Although Andersson teaches application of the components from a nozzle, the reference does not specify whether it is the same nozzle or two separate, discrete nozzles. Both Perciwall and Andersson teach that pre-curing is undesirable because it necessitates frequent cleaning of the application apparatus [Perciwall: p. 1, ll. 9-21 and Anderson: p. 1]. Based on these teachings, it would have been obvious to one of ordinary skill in the art to apply each component from its own, individual, dedicated nozzle, so as to avoid fouling of the nozzle that would require cleaning.... [Andersson] does not teach that the gluing system is an amino resin gluing system or feeding the amino resin and hardener components to at least first and second orifices, respectively.

The Office Action goes on to say on page 11:

The gluing system of Andersson is a formaldehyde-based adhesive, preferably resorcinol-formaldehyde or resorcinol-phenol formaldehyde [p. 2, ll. 5-11]. Lehnert teaches the equivalence of phenol and amino resins as conventional two-component adhesives in the art of joining wooden surfaces to form laminates, including condensation products of formaldehyde and urea and/or melamine [p. 1, ll. 28-31 and p. 3, l. 37-p. 4, l. 9].

This basis for combining Andersson and Lehnert can only be made in hindsight. Lehnert is being cited for establishing the "equivalence" of phenol and amino resins. *This is a clear error in fact.* Lehnert states merely that both phenol and amino resins are conventional, not equivalent. To argue that "conventional" means "equivalent" strains the ordinary meaning of these words. Planes, trains and automobiles are "conventional" means of transportation; that they are not equivalent is self-evident. Nowhere in Lehnert is there any statement of the equivalency of phenol and amino resins. Indeed, Lehnert establishes that phenol and amino resin systems are fundamentally different. On page 4, lines 21-28, Lehnert states:

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Attorney's Docket No. 000600-016

When the adhesive is an amino resin the hardener can for example be an inorganic or organic acid... When the adhesive is a phenol resin the edges of the veneer layers can be coated with a basic compound.

Thus Lehnert teaches that amino and phenol resin adhesive systems are different, not equivalent, and use different hardeners. There is no teaching or suggestion in Lehnert that an amino resin could be substituted for the resorcinol or resorcinol-phenol resin in Andersson, or that a volatile acid hardener could also be substituted.

Indeed the Examiner himself believes that even various resins *of the same type* are not equivalent to each other, since he asks appellants to "provide some rationale for the position that amino resins other than that in Example 1 function in an equivalent manner." [See, Interview Summary Record of October 13, 2005]. The Examiner cannot have it both ways. He cannot on the one hand argue that resins of *different* types (phenol and amino) are equivalent, and on the other hand argue that resins of the *same* type (amino) are *not* equivalent and require appellants to prove otherwise.

If there is any equivalency in Lehnert, it is that the described method of applying a hardener to the edges of a laminate can be used with conjunction with various "conventional" resin systems. However, this "equivalency" holds only in conjunction with other necessary process conditions that are completely contradictory to both Andersson and appellants' claimed invention.

For example, Andersson teaches that pre-curing is undesirable because it necessitates frequent cleaning of the application apparatus, and therefore, according to the Examiner, each component is added on its own (See, page 7 of January 14, 2005 Office Action, *supra*.) Yet Lehnert requires *mixing* of resin and hardener in the applied adhesive system (Page 4, lines 5-21). Lehnert also teaches that a separate hardener (different from that in the applied adhesive system) be applied on different laminate surfaces than the applied adhesive system. This is wholly contradictory to both appellants' and Andersson's method of applying resin and hardener on the *same* surface.

Lastly, even if there were no clear error of fact in combining Andersson and Lehnert, the combined teaching still would not result in appellants' invention. Neither reference recognizes the unexpected result of lower delamination when the amount of filler is below 20% in the adhesive. The Examiner requires a comparison of appellants' invention with that of Andersson.

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However, Andersson provides no teaching of the significance of filler levels on delamination rate. The Board of Appeals has long held that the requirement for comparing to the closest prior art precludes the USPTO from requesting test comparing the invention to subject matter not taught in the prior art. *Ex parte Westphal*, 223 U.S.P.Q. 630 (Bd. App. 1983).

For the above reasons, it is respectfully requested that the rejections be withdrawn.

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Date: August 22, 2006

Respectfully submitted,

WHITE, REDWAY & BROWN LLP

By: 

David J. Serbin

Registration No. 30,589

PTOS2/21 (07-06)

Approved for use through 09/30/2006. OMB 0851-0031

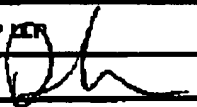
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<b>TRANSMITTAL FORM</b>  <small>(to be used for all correspondence after initial filing)</small>	Application Number	08/700,747	<b>RECEIVED CENTRAL FAX CENTER AUG 22 2006</b>
	Filing Date	November 20, 2000	
	First Named Inventor	Beryahle Nass-Bakir et al	
	Art Unit	1752	
	Examiner Name	William P. Fletcher III	
Total Number of Pages in This Submission	Attorney Docket Number	000600-006	

ENCLOSURES (Check all that apply)		
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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	WRB-IP LLC		
Signature			
Printed name	David J. Serbin		
Date	August 22, 2006	Reg. No.	30,680

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